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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/684,861

10/06/2000

Paul Bilibin

PSTM0024/MRK

2827

29524

7590

12/30/2010

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PASADENA, CA 91101-4710

EXAMINER

PATS, JUSTIN

ART UNIT

PAPER NUMBER

3623

MAIL DATE

DELIVERY MODE

12/30/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/684,861	Applicant(s) BILIBIN ET AL.	
	Examiner JUSTIN M. PATS	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 13 and 19-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 13 and 19-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/5/10 (6)</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 10/4/10 has been entered, in which Applicant amended claims 1–10, and 22–23, and cancelled claims 11–12, and 15–17. Claims 1–19, 13, 19–23 are pending in the Application and have been rejected below. Information Disclosure Statements (IDS) filed 10/5/10 have been considered.

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Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1–2, 7–9, 10, 13, and 19–22 recite computer system claims (1–2, 10, 13, and 19–22) and computer program product claims (7–9) programmed to perform a plurality of method steps. These recitations amount to mere data structures as they do not positively recite any structural components of the system in the body of the claim, and therefore could merely comprise the program code or modules for performing the steps of the invention. Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d 1354, 1361 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. See MPEP 2106.01 (I). As currently claimed, the system of claims 1–2, 10, 13, and 19–22 does not recite any physical components or structure in the body of the claim, and the computer program product of claim 7–9 could merely be a set of code or instructions and devoid of structure; therefore, these claims are considered non-statutory.

4. Based upon consideration of all of the relevant factors with respect to the claim as a whole, claim(s) 4–5, and 23 are held to claim an abstract idea, and is/are therefore rejected as ineligible subject matter under 35 U.S.C. 101. The rationale for this finding is explained below:

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Claims 4–5, and 23 are directed to non-statutory subject matter because they fail to meet the legal requirements of a 'process'. The first step in determining whether a claim recites patent eligible subject matter is to determine whether the claim falls within one of the four statutory categories of invention recited in 35 U.S.C. § 101: a process, machine, manufacture and composition of matter. The latter three categories define "things" or "products," while a "process" consists of a series of steps or acts to be performed. For the purposes of § 101, federal case precedent has given a "process" a specialized, and limited meaning. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876). A useful and important clue to determining a process meets 35 U.S.C. § 101 is that it either (1) is tied to a particular machine or apparatus or (2) transforms a particular article to a different state or thing. If neither of these requirements is met by the claim, the method may not be a patent eligible process under § 101.

Furthermore, although the text of section 101 is broad, it is not without limit in that its precedents provide three specific exceptions to § 101's broad patent-eligibility principles, laws of nature, physical phenomena, and abstract ideas.

To assist in qualifying as a statutory process under § 101, the claim may positively recite the machine to which it is tied (e.g. by identifying the apparatus that accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g. by identifying the material that is being changed to a different state). The use of a particular machine or transformation of an article should impose meaningful limits on the claim's scope to impart patent-eligibility—as such, nominal recitations of structure in an otherwise ineligible method

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may fail to make the method a statutory process. See *Bilski*, 545 F.3d at 957; *Benson*, 409 U.S. at 71-72. Also, incidental physical limitations such as insignificant extra-solution activity and field of use limitations are not sufficient to convert an otherwise ineligible process into a statutory one. See *Flook*, 437 U.S. at 590.

Examiner further notes that generally, the positive recitation of the particular machine nexus should be in the body rather than the preamble of the claim so as avoid a nominal recitation of structure determination. Specifically, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976); *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Additionally, a preamble generally is not limiting when the claim body describes a structurally complete invention such that deletion of the preamble phrase does not affect the structure or steps of the claimed invention. See MPEP 2111.02.

Regarding prong (1), here, the claims recite a method of using a computer system for managing shipping of a plurality of parcels shipped by any one carrier, wherein the methods receive, determine, and calculate data. As to claims 4–5 and 23, Examiner first notes that Applicant has claimed in the preamble using a computer system for performing the following steps. However, this recitation may be considered nominal and not necessary to performance of the method if not further supported in the body of the claim. In the instant case, there is no recitation of structure in the body of the claim, and there is no further explanation in the preamble that particularly connects the computer system to the method steps in any particular

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manner. As such, the method claims' computer system recitations are considered nominal and insignificant extrasolution activity, and do not render a sufficient tie to a particular machine or apparatus. Therefore, claims 4–5, and 23 fail the machine prong of the machine-transformation test.

Regarding prong (2), Examiner notes that the Federal Circuit has held unpatentable a process of graphically displaying variances of data from average values that neither specified any particular type or nature of data nor how or from where the data was obtained or what the data represented. In *re Abele*, 684 F.2d 902, 909; see also In *re Meyer*, 688 F.2d 789, 792-93 (CCPA 1982) (process claim involving undefined "complex system" and indeterminate "factors" drawn from unspecified "testing" not patent-eligible). In contrast, the court has held one of Abele's dependent claims to be drawn to patent-eligible subject matter where it specified that "said data is X-ray attenuation data produced in a two dimensional field by a computed tomography scanner"; wherein this data clearly represented physical and tangible objects, namely the structure of bones, organs, and other body tissues. *Abele*, 684 F.2d at 908-09. Thus, the transformation of that raw data into a particular visual depiction of a physical object on a display was sufficient to render that more narrowly-claimed process patent-eligible. In our case, the data received in claim 4 is being used to determine and calculate data as per claims 4 and 5 respectively. However, neither of these operations renders a representation of a physical thing or a change from one type of data to another. As such, the claimed process reflects the unpatentable claim in *Abele* in that it uses data to make a determination but the data itself maintains its same representative form, rather than the patentable claim in *Abele*, in which the raw data was used to create a visual representation of a physical object. Therefore, claims 4–5 and 23 are considered

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non transformational and do not meet this prong of the machine-transformation test under 35 U.S.C. 101.

Finally, there is no clear indication that the method is not directed to an abstract idea relating to shipping methodology. In particular, both known and unknown uses of the concept are covered, and can be performed through any existing or future-devised machinery, or even without any apparatus. As such, the methods of claims 4–5 and 23 do not meet the requirements of 35 U.S.C. 101 and are considered non statutory.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1–10, 13, 19–23 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention.

7. In the IDS filed 8/22/01, Applicant submitted a declaration describing various historical information and agreements relating to the claimed invention. One of said agreements was between MoveIt! (which later became iShip.com, the assignee of instant application) and College Enterprises, Inc., dating back to November 1997. Applicant's Declaration, 8/22/01, pg. 3–7, ¶¶ 15–22; pg. 99–104, Letter between CEOs of MoveIt! and College Enterprises, Inc., detailing agreement, and the agreement itself. This agreement provided for the installation of MoveIt! software at stations or kiosks in shipping stores on a public university's college campus, for public use by students and faculty, both of whom are members of the public. Furthermore, the agreement comprised a revenue sharing provision in which "CEI and MoveIt! agree[d] "to share 50/50 the 'gross profits' generated by the package shipments that are the result of shippers using the MoveIt! Stations at Pulse Centers or elsewhere on colleges and universities represented by CEI." Applicant's Declaration, 8/22/01, pg. 99–100, Letter between CEOs of MoveIt! and College Enterprises, Inc. Despite Applicant's attempt at couching the agreement as one of beta

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testing and experimentation, the establishment of which may provide safe harbor to Applicant's public use and/or sale of the invention, it is evident from the declaration, and specifically the agreement documentation, that members of the public, namely students, faculty, and possibly others, used the on-campus shipping store stations to facilitate shipment of packages, and that based on the language of the agreement, there was a material intention by MoveIt! to generate revenue based on those students, faculty, and possibly others' public use of the claimed invention, all of which occurred more than one year before Applicant's earliest potential filing date of October 6, 1999. As such, there is at least a prima facie case of a public use or on-sale bar that needs establishment as done so hereinabove, and a response to which is required.

8. Examiner notes that an issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows: (1) Any further information relating to the agreement between MoveIt! Software, Inc. and College Enterprises, Inc. and the implementation of the agreement, including, for example, relating to who had access to the shipping stations and shipping software (i.e., was it open to any member of the public or just particular individuals), whether those who had access were required to sign any nondisclosure agreements of any kind), any evidentiary support of the purported beta testing process showing or logging the discovery of defects and repair thereof, also including the makeup of the various versions of the software leading up and in comparison to the production release software; and (2) whether any revenue, money, or other consideration was transacted or agreed to be transacted more than a year before the invention in any way relating to the

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MoveIt!/CEI agreement and/or any other of MoveIt's many other agreements directed to the claimed invention, and if so, any further information regarding which that is available to Applicant.

Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1–2, 4–5, 7–8, 22–23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thiel (U.S. 5,699,258) in view of FedEx (www.fedex.com).

11. As per claim 1, Thiel discloses a shipping management computer system (Fig. 1; col. 8, lines 2–4, discussing hardware/software, microprocessor implementation of the invention; claims 7 and 19, discussing memory and means for reading a chip card), said computer system programmed to: receive a request by a particular user to ship a particular parcel, said request comprising a first address and a second address, and an indication of a shipping date (column 8, line 45–66, wherein a request of a user to ship a parcel from a first address (country or place of origin) to a second address (receiving location), is received; col. 3, lines 25–28, discussing ability of operator to input country or place of origin; col. 7, line 64–col. 8, line 2, disclosing that the device has means in the control module that select the postage rate based on the date; see also col. 9, lines 7–10, disclosing that the date is entered for each table; col. 9, lines 40–41, discussing date being manually input; col. 10, lines 45–47, discussing that date may be displayed in the information field in order to make a selection of functions); in response to the request, determine

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a simultaneous potential cross-comparison delivery schedule, said simultaneous respective cross-comparison delivery schedule comprising a plurality of respective service-specific carrier-specific delivery schedules to ship the particular respective parcel from the first address to the second address, according to the indication of the shipping date, each respective service-specific carrier-specific delivery schedule corresponding to a respective particular delivery service of a plurality of delivery services offered by a particular carrier of a plurality of carriers, each respective service-specific, carrier specific delivery schedule comprising corresponding respective delivery services by a corresponding respective particular carrier of the plurality of carriers to deliver the particular respective parcel from a first address to the second address according to the indication of the shipping date, said simultaneous potential cross-comparison delivery schedule comprising a respective service-specific, carrier specific delivery schedule for each respective particular delivery service of the plurality of delivery services offered by each respective particular carrier of the plurality of carriers that would deliver the particular respective parcel from the first address to the second address according to the indication of the shipping date (See abstract, column 4, line 60-column 5, line 15, column 8, line 45-66, column 11, lines 1-25 and 46-54, wherein a request of a user to ship a parcel from a first address to a second address is received and a comparison is generated concerning multiple carriers using carrier specific data and the services offered. See figure 1, column 2, lines 35-61, column 3, lines 9-26, column 7, lines 25-35, and column 10, lines 15-35, all of which discuss the architecture of the system including a communications network and a client device; see also col. 9, lines 7-24, discussing date as a factor in certain rates and shipping options being available).

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Thiel does not explicitly teach, wherein the delivery schedule comprises a respective calendar delivery date and time for a corresponding service. However, FedEx, in the analogous art of shipping logistics, discloses a carrier offering shipment types, wherein shipment types comprise a respective delivery date and a respective delivery time (See pages 2-3, page 5, section 1, and page 6, which disclose the different service types offered along with a delivery date and time associated with the delivery).

Thiel discloses that the date of the shipment is input into the system and also discloses shipment types for carriers, these shipment types including express mail, priority, etc. FedEx discloses a respective delivery date and a respective delivery time for each service type for the carrier, such as if the current date was 12/12/05, the shipment type “priority overnight” would give the delivery date of 12/13/05 with the delivery time of 10:30. Therefore, since Thiel discloses specifying a date of shipment in the system and types of services that include guaranteed times to delivery, it would have been obvious to one of ordinary skill in the art at the time of the invention to include displaying the delivery date and delivery time of the carrier, such as the dates and times set forth in FedEx, in order to increase user satisfaction with shipping items by showing a display containing more comprehensive information about the service types offered by the competing carriers, thus aiding the user in the selection of a proper carrier. See column 10, lines 55-67, and column 11, lines 45-55, of Thiel.

12. As per claim 2, Thiel teaches a shipping management computer system, said computer system further programmed to: calculate a respective shipping rate for each said respective particular delivery service to deliver the particular respective parcel according to the respective

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service-specific carrier-specific delivery schedule (See column 4, line 60-column 5, line 15, column 6, lines 49-55, column 8, line 45-66, column 10, line 65-column 11, line 25 and 46-54, wherein a shipping rate is calculated for each carrier).

13. Claims 4, 5, 7, and 8 recite limitations that stand rejected via the art citations and rationale applied to claims 1, 2, 1, and 2, respectively as discussed above.

14. As per claims 22 and 23, Thiel discloses the date of shipping and planning delivery based on the shipment type, such as express mail (See column 4, line 60-column 5, line 15, column 8, line 45-66, column 11, lines 1-25 and 46-54, wherein a request of a user to ship a parcel from a first address to a second address is received and a comparison is generated concerning multiple carriers using carrier specific data and the services offered). However, Thiel does not expressly disclose and FedEx discloses a respective calendar delivery date and respective delivery time, wherein the respective delivery date and respective delivery time correspond, respectively, to a date and time (See pages 2-3, page 5, section 1, and page 6, which disclose the different service types offered along with a delivery date and time associated with the delivery).

Thiel discloses that the date of the shipment is input into the system and also discloses shipment types for carriers, these shipment types including express mail, priority, etc. FedEx discloses a respective calendar delivery date and a respective delivery time for each service type for the carrier, such as if the current date was 12/12/05, the shipment type "priority overnight" would give the delivery date of 12/13/05 with the delivery time of 10:30. Therefore, since Thiel discloses specifying a date of shipment in the system and types of services that include

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guaranteed times to delivery, it would have been obvious to one of ordinary skill in the art at the time of the invention to include displaying the delivery date and delivery time of the carrier, such as the dates and times set forth in FedEx, in order to increase user satisfaction with shipping items by showing a display containing more comprehensive information about the service types offered by the competing carriers, thus aiding the user in the selection of a proper carrier. See column 10, lines 55-67, and column 11, lines 45-55, of Thiel.

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15. Claims 3, 6, 9–10, 13, and 19–21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thiel (U.S. 5,699,258) in view of FedEx (www.fedex.com) further in view of Barns-Slavin et al., U.S. Pat. 5,117,364 [hereinafter Barns-Slavin].

16. As per claim 3, Thiel teaches the shipping management computer system further programmed to: in response to the request, generate a display of an online, interactive prompt for display to a display monitor configured with a respective user client computer device associated with the particular user, said online interactive prompt comprising a simultaneous potential cross-comparison of each of said respective shipping rates for each said particular delivery service, the display of each of said respective shipping rates corresponding to a display of the respective service-specific carrier-specific delivery schedule for the particular delivery service to deliver the particular respective parcel(See column 6, lines 7-11 and 50-55, column 7, lines 15-30, column 10, lines 45-64, column 11, lines 45-55, wherein a display shows a cross comparison of multiple carriers by plans, charges, and types. See figure 1, column 2, lines 35-61, column 3, lines 9-26, column 7, lines 25-35, and column 10, lines 15-35, all of which discuss the architecture of the system including a communications network and a client device connected to the network), said online interactive prompt configured for receiving a user's indication of selection of a particular respective shipping rate (col. 11, lines 45–55, discussing that the user can choose its desired shipping rate relating to a particular carrier). Thiel teaches a printer module (Fig. 1, ref. 7), but does not explicitly teach, nor does FedEx, wherein the prompt is for responding to the user's indication of a selection of the particular respective shipping rate with a printing of a shipping label for shipment of the particular respective label using a particular

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delivery service offered by a particular carrier associated with the particular respective shipping rate.

However, Barns-Slavin, in the analogous art of carrier shipping rate analysis, teaches this concept (Fig. 6, refs. 403–404, Rate Shopping, ref. 406, Press Print Key; claim 3, disclosing that the printer prints parcel shipping information; col. 3, lines 25–30, discussing shipping charges determined and printing of a label relating to the shipping of the parcel). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Thiel to include the teaching of Barns-Slavin, providing the benefit of expedited processing and therefore increased operational efficiency and productivity.

17. Claim 6 recites limitations similar to claim 3, the key difference being instead of printing a shipping label as in claim 3, claim 6 more broadly reciting the system's response as merely one that facilitates shipment of a parcel with the particular carrier and shipping rate, and delivery service as determined in claims 1 and 4. Again, Thiel does not explicitly teach this concept, but Barns-Slavin does via its label printing capabilities as discussed in the rejection of claim 3 above. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Thiel to include the teaching of Barns-Slavin, providing the benefit of expedited processing and therefore increased operational efficiency and productivity.

18. Claims 9 recites limitations that stand rejected via the art citations and rationale applied to claim 6 as discussed above.

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19. As per claim 10, Thiel teaches a shipping management computer system for: allowing a user to request a package delivery service by providing shipping specifications to ship a particular parcel, said shipping specifications comprising parcel information, a first address, a second address, and an indication of a shipping date (see discussion supra ¶ 11; see also column 4, line 60-column 5, line 15, column 8, line 45-66, column 11, lines 1-25 and 46-54, wherein a request is allowed to the system); receiving said shipping specifications from said user (See column 3, lines 35-42, column 8, line 45-66, column 11, lines 1-25 and 46-54, wherein the specifications of the origin and destination are received, as well as a weight and type of mail); identifying, from a plurality of carriers, a subset of carriers based on said shipping specifications, each of said subset of carriers being identified as capable of satisfying said shipping specifications by providing said package delivery service to said user (See abstract, column 4, line 60-column 5, line 15, column 8, line 45-66, column 11, lines 1-25 and 46-54, wherein a subset of carriers are identified based on the provided specifications); identifying a first carrier from said subset of carriers and a first set of shipment types provided by said first carrier (See abstract, column 4, line 60-column 5, line 15, column 8, line 45-66, column 11, lines 1-25 and 46-54, wherein the different type of shipments are identified for the first carrier, such as express, air, priority mail or general delivery); determining a first set of delivery schedules according to which said first carrier would be able to satisfy said shipping specifications, each one of said first set of delivery schedules corresponding to at least one of said first set of shipment types (See column 4, line 60-column 5, line 15, column 8, line 45-66, column 11, lines 1-25 and 46-54, which discloses the delivery schedules associated with the shipping specifications, such as next day delivery); calculating a first set of service charges by said first carrier, each one of said first

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set of service charges calculated based upon at least one of said first set of shipment types provided by said first carrier (See column 4, line 60-column 5, line 15, column 6, lines 49-55, column 8, line 45-66, column 10, line 65-column 11, line 25 and 46-54, wherein charges are calculated); identifying a second carrier from said subset of carriers and a second set of shipment types provided by said second carrier (See abstract, column 4, line 60-column 5, line 15, column 8, line 45-66, column 11, lines 1-25 and 46-54, wherein the different type of shipments are identified for a second carrier, such as express, air, priority mail or general delivery); determining a second set of delivery schedules that said second carrier is capable of providing to said user, each one of said second set of delivery schedules corresponding to at least one of said second set of shipment types (See column 4, line 60-column 5, line 15, column 8, line 45-66, column 11, lines 1-25 and 46-54, which discloses the delivery schedules associated with the shipping specifications, such as next day delivery); calculating a second set of service charges by said second carrier, each one of said second set of service charges calculated based upon at least one of said second set of shipment types provided by said second carrier (See column 4, line 60-column 5, line 15, column 6, lines 49-55, column 8, line 45-66, column 10, line 65-column 11, line 25 and 46-54, wherein charges are calculated); and simultaneously displaying to the user an interactive prompt comprising said first set of delivery schedules, an interactive display of said first set of service charges, said first set of shipment types (See column 6, lines 7-11 and 50-55, column 7, lines 15-30, column 10, lines 45-64, column 11, lines 45-55, wherein the user displays plans, charges, and types of a first carrier), said second set of delivery schedules, said second set of service charges, and said second set of shipment types, said interactive prompt configured for receiving a user's selection of one of said first service charges or said second set of service

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charges (See column 6, lines 7-11 and 50-55, column 7, lines 15-30, column 10, lines 45-64, column 11, lines 45-55, wherein the user displays plans, charges, and types of a second carrier).

However, while Thiel discloses the date of shipping and planning delivery based on the shipment type, such as express mail, Thiel does not expressly disclose a calendar delivery date and time. FedEx discloses a carrier offering shipment types, wherein shipment types comprise a respective delivery date and a respective delivery time (See pages 2-3, page 5, section 1, and page 6, which disclose the different service types offered along with a delivery date and time associated with the delivery).

Thiel discloses that the date of the shipment is input into the system and also discloses shipment types for carriers, these shipment types including express mail, priority, etc. FedEx discloses a respective delivery date and a respective delivery time for each service type for the carrier, such as if the current date was 12/12/05, the shipment type “priority overnight” would give the delivery date of 12/13/05 with the delivery time of 10:30. Therefore, since Thiel discloses specifying a date of shipment in the system and types of services that include guaranteed times to delivery, it would have been obvious to one of ordinary skill in the art at the time of the invention to include displaying the delivery date and delivery time of the carrier, such as the dates and times set forth in FedEx, in order to increase user satisfaction with shipping items by showing a display containing more comprehensive information about the service types offered by the competing carriers, thus aiding the user in the selection of a proper carrier. See column 10, lines 55-67, and column 11, lines 45-55, of Thiel.

Furthermore, Thiel in view of FedEx does not explicitly teach wherein the interactive prompt is configured for responding to the user’s selection by facilitating shipment of the

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particular parcel using a particular shipment type offered by a particular carrier associated with a service charge associated with the user's selection. However, Barns-Slavin, in the analogous art of carrier shipping rate analysis, teaches this concept, facilitating shipment by printing a label for the parcel with its particular shipping information (Fig. 6, refs. 403–404, Rate Shopping, ref. 406, Press Print Key; claim 3, disclosing that the printer prints parcel shipping information; col. 3, lines 25–30, discussing shipping charges determined and printing of a label relating to the shipping of the parcel). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Thiel to include the teaching of Barns-Slavin, providing the benefit of expedited processing and therefore increased operational efficiency and productivity.

20. As per claim 13, Thiel teaches wherein said first set of shipment types comprise ground shipment, next day air, and express shipment (See column 8, line 45-66, which discloses the shipment types).

21. As per claim 19, Thiel discloses wherein said first set of delivery schedules comprises: a delivery schedule according to which said first carrier would be able to satisfy said shipping specifications via a first shipment type (See abstract, column 4, line 60-column 5, line 15, column 8, line 45-66, column 10, line 56-column 11, line 1-25 and 46-54, which is the first carrier that is able to satisfy the shipping request of a first type); and a delivery schedule according to which said first carrier would be able to satisfy said shipping specifications via a second shipment type, said second shipment type being different from said first shipment type (See abstract, column 4, line 60-column 5, line 15, column 8, line 45-66, column 10, line 56-

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column 11, line 1-25 and 46-54, which is the first carrier that is able to satisfy the shipping request of a second type).

22. As per claim 20, Thiel teaches wherein said second set of delivery schedules comprises: a delivery schedule according to which said second carrier would be able to satisfy said shipping specifications via said first shipment type (See column 4, line 60-column 5, line 15, column 8, line 45-66, column 10, line 56-column 11, line 1-25 and 46-54, which shows a second carrier able to satisfy the specifications for the first type).

23. As per claim 21, Thiel teaches wherein said second set of delivery schedules comprises: a delivery schedule according to which said second carrier would be able to satisfy said shipping specifications via said second shipment type (See column 4, line 60-column 5, line 15, column 8, line 45-66, column 10, line 56-column 11, line 1-25 and 46-54, which shows a second carrier able to satisfy the specifications for the second type).

Response to Arguments

24. Applicant's arguments filed 10/4/10 have been fully considered but they are not persuasive.

25. Applicant's arguments regarding amended independent claim 1 do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections. Even so, it is Examiner's position that the cited prior art combination Thiel in view of FedEx still renders obvious claim 1 as explained above. See discussion supra ¶ 11.

26. Applicant's arguments with respect to claim 3 have been considered but are moot in view of the new ground(s) of rejection and also do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Conclusion

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. Sharpe et al., U.S. Pat. 5,222,018 (disclosing a shipping system that simultaneously tracks and displays shipment information for multiple carriers).

B. Schwartz et al., U.S. Pat. 5,841,076 (disclosing a shipping system that includes a displayable and selectable rate finder for a plurality of carriers and a plurality of services).

C. A 'Blue Chip' Mailroom Investment, Modern Office technology, Vol. 29, No. 8, Aug. 1984, pg. 98 (online reprint pg. 1–3) (discussing a computer system that calculates shipping rates for packages over multiple carriers).

D. Canna, A supermarket for transport services, American Shipper, Vol. 34, No. 5, May 1992, pg. 45(4) (online reprint pg. 1–6) (disclosing a computer based shipping system that includes a multimodal pathfinder that determines available modes, carriers, routes, and schedules and recommends best alternatives).

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E. Williams, Intershipper Finds Cheapest Shipping Rates, Newsbytes, Feb. 18, 1998, pg. 1–3 (disclosing computer-based shipping system called Intershipper that can retrieve and display shipping rates to user from all major shippers simultaneously).

F. Press Releases, wwmerchant.com, retrieved from web.archive.org, March 25, 2000, pg. 1–4 (disclosing a series of press releases dated prior to Applicant’s effective filing date about Intershipper and its features and developments).

G. *TanData and iCat allow you to ‘pick how you ship’*; TanData announces Prologistics.Merchant shipping and handling component for latest version of iCat's Electronic Commerce Suite, 3.0, Feb. 10, 1997, pg. 1–2 (disclosing information about Prologistics.Merchant, computer-based shipping software that can calculate shipping costs for various carriers and various services of those carriers).

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUSTIN M. PATS whose telephone number is (571)270-1363. The examiner can normally be reached on M-F, 8am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Beth Boswell can be reached on 571-272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Justin M Pats/
Examiner, Art Unit 3623